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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3661

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/648,532	Applicant(s) EMODI ET AL.	
	Examiner CUONG H. NGUYEN	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 57-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 57-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is the answer to the amendment received on 3/18/05.
2. Claims 1-28, 57-61 are pending, wherein new claims 59-61 have been added.

Response

3. The examiner withdrawn previous 35 USC 102 rejections. Based on the claims' amendments, new ground(s) of rejections are applied to pending claims to show that claimed limitations are not inventive; the arguments for previous grounds of rejections are moot. Applicants' amendment make several pending claims broader; the examiner respectfully submits that critical amended claims 1, 57 are carefully analyzed below, other amended/broader claims at least have similar rationale for obviousness rejections. The examiner respectfully disagrees about the assertion on page 14, 1st para. "An audio tract alone does not each a music track"; the position of the examiner simply is: merely recording a sound track.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418).**

They are directed to an apparatus having a telephony platform, a memory that storing sound/voice/music track(s).

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Bro sufficiently meets that claimed limitations by teaching an apparatus for storing predetermined multimedia information (see Bro, Fig.1) according to a client's command, comprising:

a telephony platform (see Bro, Fig.1 ref. 24 & 6:1-10); and

a storage location coupled to said telephony platform, wherein said storage location stores predetermined multimedia information (see Bro, Fig.1, ref.16 – software inherently being stored in a storage device/location such as a ROM, RAM, a hard-disk, a floppy disk, an optical storage device .etc.).

Dependent claim 57 further defines components of a telephonic platform: means for managing (i.e., a microprocessor/controller), means for storing message (i.e., a storage device: CD ROMs), a means for converting signals for a proper format (inherently being install in Bro's apparatus), and a means for generating control signals to input to a telephonic platform (i.e., signals from "CLIENT DTMF TELEPHONE SET 26" to control "TELEPHONE NETWORK 24". Please note that Bro suggests about: means for managing "COMPUTER 16", means for storing messages "RECORDING DEVICE 46", means for converting electrical signals "DIGITAL/TELEPHONE TONE SIGNAL CONVERVER 18", and means for generating control signals (i.e., Bro teaches about a converter to converting a signal generating from a telephone keypad in Fig.1 "DIGITAL/TELEPHONE TONE SIGNAL CONVERTER 18".

For dependent claim 58, Bro suggests about interconnections among components of Fig.1's apparatus (i.e., electronics/electrical paths between means for managing (with a COMPUTER 32), means for storing messages (in a DATABASE 12), means for converting (DIGITAL/TELEPHONE TONE SIGNAL CONVERTER 18), and means for generating control

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signals (FROM/TO COMPUTER 16) – these “backbone” are fundamental components/paths/buses in electronic circuits (see Bro, Fig.1).

Bro does not intent to use his apparatus for storing selected music/video track(s).

However, this claim is directed to an apparatus comprising physical components to make-up that apparatus; therefore, his apparatus can be used for storing selected music/video tracks.

It would have been obvious to one with ordinary skill in the art at the time of the invention to implement Bro’s apparatus in handling multi-media signals (voice/text/video) since Bro’s apparatus is capable of selecting a particular environment for a user (i.e., recording a selected music track); the motivation is providing an apparatus that can do a specific selection.

5. Claims 2, 25-28, and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), in view of Foladare et al. (US Pat. 6,343,115).

The rationales and reference for a rejection of claim 1 are incorporated.

A. Re. to claim 2: Foladare et al. also teach about:

- a second storage location coupled to said first telephony platform, wherein said first telephony platform receives a multimedia command from an access device of a user, (see Foladare et al., Fig.1, ref. 116, and the abstract), wherein said first storage location and said second storage location store multimedia information, wherein a first multimedia portion of said predetermined multimedia information is stored in said first storage location and a second multimedia portion of said predetermined multimedia information is stored in said second storage location, said first telephony platform selectively reproduces one of said first multimedia portion and said second multimedia portion as a selected multimedia portion based on said at

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least one multimedia command, and wherein said first telephony platform outputs said selected multimedia portion to said access device.

It would have been obvious to one with ordinary skill in the art at the time of the invention to implement Bro's apparatus with Foladare et al.'s ideas for using a second storage device to stored second multimedia portion because this clearly defines a separate role for different storage devices.

B. Re. to claim 57-58: Foladare et al. further describe functional components that make up claimed apparatus – those claims 56-57 read-on the functions of Foladare et al.'s system (i.e., functions done by Foladare's microprocessor, memory devices, and a certain software to perform those functions; Foladare et al. also provide a "high-speed" connection in their system (please note that there is no definition for "high-speed" in the claim – this is a term-of-degree to be compared to "a standard speed" that is not revealed).

C. As to claim 25: The rationales and reference for a rejection of claim 2 are incorporated.

Foladare et al. further teach a system/an apparatus that having capabilities of receiving/sending an information command; and wherein a telephony platform outputs a message to access devices (see Foladare, Fig.1).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, and capabilities of Foladare's system in handling multi-media signals (voice & text/video) since Foladare further teaches a system to receive a voice signal, storing/saving it in database, converting/transforming it to an understandable/readable format corresponding to what Foladare's system design, and outputting/ forwarding said (converted) understandable/readable signal.

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D. As to claim 26: The rationales and reference for a rejection of claim 2 are incorporated.

Foladare et al. also teach an apparatus that having capabilities of an access command comprises a multiple user session command, and wherein a platform connects different users (see Foladare, Fig.1); therefore, the combination of Bro and Foladare et al. provide more flexibilities/conveniences to an apparatus for ordering a selection of music/video tracks.

Claim 26 phrases: “with access devices of other users who are interested in topics relating to said selected multimedia portion so that said user and said other users can communicate in a multiple user session”, the examiner respectfully submits that a claim directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function “even if not directly disclosed”, it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

E. As to claims 27-28: The rationales and references for a rejection of claim 26 are incorporated.

Foladare et al. also teach a telephone party line in an Internet environment for a multiple-user (see Foladare, Fig.1).

Bro and Foladare et al. do not disclose that a multiple-user session corresponds to a chat room.

However, the examiner respectfully submits that a limitation on a claim can broadly be thought as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful structure/apparatus, or properties of the claimed invention will not serve as a limitation. See *In*

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re Gulack, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims, (“multiple user session corresponds to a chat room” are not functionally interrelated to make-up said claimed apparatus).

It would have been obvious to one with ordinary skill in the art at the time of the invention to suggest that a combination of Bro, and Foladare et al.’s apparatus would be used in an environment such as a multiple-user session corresponds to a chat room.

6. As to claim 3: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), in view of Foladare et al. (US Pat. 6,343,115).

The rationales and references for a rejection of claim 2 are incorporated.

Bro also discloses that multimedia information comprises voice/music information (see Bro, 54:8-34).

7. As to claims 4: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), in view of Foladare et al. (US Pat. 6,343,115), and further in view of Barbara et al. (US Pat. 5,926,789).

The rationales and references for a rejection of claim 3 are incorporated.

Bro and Foladare et al. do not expressly disclose about an apparatus having multimedia music tracks.

However, Barbara et al. teach that feature (see Barbara et al., 6:1-14 wherein “an audio track” is clearly a musical/multimedia track).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Foladare et al. and Barbara et al. to define communicate information

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are also music tracks because Barbara et al., define a location to retrieve a specific music which is implemented in Bro and Foladare et al.'s systems (the examiner notes that the "printed material" as "music track" is claimed here instead of information track (which making-up the claimed apparatus).

8. As to claim 5: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of Foladare et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and further in view of Aktas et al. (US Pat. 6,459,776).

The rationales and references for a rejection of claim 4 are incorporated.

Bro, Ellis et al., and Foladare et al. do not expressly disclose a first mailbox and a second mailbox in their apparatus.

However, Aktas et al. teach those features (see Aktas et al., claim 15).

Foladare et al. do not expressly disclose about a navigating menu.

However, Ellis et al., or Barbara et al. teach that feature (see Ellis et al., Fig.19; or see Barbara et al., 6:21-30, wherein a user can make an on-screen selection).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Ellis et al., Foladare et al., Aktas et al., and Barbara et al. to generate an apparatus having a navigating menu and different mailboxes because this would give flexible selections for a user, and also a capability of comfortable navigating a menu to a user for a selection.

9. As to claims 6-7: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in

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view of Foladare et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and further in view of Aktas et al. (US Pat. 6,459,776).

A. Re. to claim 6: The rationales and references for a rejection of claim 5 are incorporated.

Ellis et al., Foladare et al., Barbara et al., and Aktas et al. do not expressly disclose an apparatus wherein inputs comprise artist name, album name, and type of music of a music track.

However, these claimed differences are only found in the non-functional descriptive material and are not functionally involved in the claimed apparatus recited. The artist name, album name, and type of music of a music track would be “information” regardless of what kind of specific data. Thus, this “descriptive material” limitation will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use Bro, Ellis et al., Foladare et al., Barbara et al., and Aktas et al. to input any type of data or any type of content. because such data does not functionally relate to the apparatus claimed (not changing a function of “inputting”), and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

It would have been obvious to one with ordinary skill in the art at the time of the invention to understand that the combination of Bro, Ellis et al., Foladare et al., Barbara et al., and Aktas et al. would generate an apparatus with structural components as claimed because a limitation on a claim can broadly be thought as its ability to make a meaningful contribution to the definition of the invention in a claim.

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B. As to claim 7: This claim is rejected on obviousness as claim 6 because claimed music tracks contain non-functional descriptive material for an apparatus claim (i.e., a specific album/an album's name).

10. As to claims 9-10, and 12-13: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of Foladare et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and further in view of Aktas et al. (US Pat. 6,459,776).

The rationales and reference for a rejection of claim 7 are incorporated.

Bro, Ellis et al., and Foladare et al. teach a structural system in that a command controls/instructs a telephony platform (e.g., see Foladare et al., Fig.1).

Bro, Ellis et al., and Foladare et al. do not expressly disclose about a "purchase" command instructs said telephony platform to have a copy of said album downloaded/mailed to a user's address.

However, executing a purchasing command "to have a copy of said album mailed to a user's postal address" is an intent of use of claimed apparatus, thus this phrase contains a well-known limitation which is not an inventive concept. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Ellis et al., Foladare et al., Aktas et al., and Barbara et al. to generate Foladare et al.'s system with an intend of use as "to have a copy of said album mailed to a user's postal address" because this would be merely a specific application of a user that is already well-known.

11. As to claim 14. It is rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), in view of Foladare et al. (US Pat. 6,343,115), and further in view of

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Barbara et al. (US Pat. 5,926,789).

The rationales and reference for a rejection of claim 4 are incorporated.

Bro or Foladare et al. do not expressly disclose that about a multimedia command is a save command, wherein said first music track corresponds to said selected multimedia portion, wherein, after selecting said first music track, said user saves first data corresponding to said first music track in a user memory portion coupled to said at least said first telephony platform by inputting said save command, and wherein said user memory portion is assigned to said user.

However, claiming that "a command is a save command" would be obvious for that claimed apparatus because cited references' structure are capable to perform "a save command" which is a fundamental feature for most computer's applications; further Bro obviously performs a saving after selecting which read-on the claimed action of "wherein, after selecting said first music track, said user saves first data corresponding to said first music track in a user memory portion coupled to said at least said first telephony platform by inputting said save command, and wherein said user memory portion is assigned to said user" (see Bro, 39:56-65, and 57:64 to 58:3).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Foladare et al., and Barbara et al. because their combinations have all structural components that make-up the claimed apparatus; that apparatus would perform a save command.

12. As to claims 8, 11, 15-19: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US Pat. 5,722,418), in view of Foladare et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), in view of Ellis et al. (PGPUB-DOCUMENT-

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NUMBER: 20030188313), and further in view of Kelkar et al. (US Pat. 6,182,128).

The rationales and references for a rejection of claim 14 are incorporated.

Bro, Foladare et al. and Barbara et al. do not expressly disclose that first data are music data/pointer data of a first music track.

However, Kelkar et al. disclose that music data are indexed (by music tracks); therefore, first track can be used as a pointer for retrieving - (see Kelkar et al., 4:55 to 5:4).

It would have been obvious with one of ordinary skill in the art to combine Bro, Foladare et al., Barbara et al., Ellis et al., and Kelkar et al. to suggest that first music data are belongs to a first music track because the order of input data are maintained with the order of track for easy recognition; furthermore, this "order" is a non-descriptive material for an apparatus claim that does not contribute to a physical structure of that claimed apparatus; similarly, additional save commands can be used for additional music tracks -- this is obvious by repetitions.

As to claims 8, 11, 18-19: These apparatus claims contain multimedia command, purchasing commands.

The rationales and references for obviousness rejection or claim 17 are incorporated.

Ellis et al., suggest a selection to purchase a particular movie channel (see Ellis et al., Fig.26).

Claim 19 comprises a purchasing command and a telephony platform (please note that the following claimed language does not contribute much weight -- as a proper limitation of this "apparatus" claim - because it comprises an action/step/function not comprising "a physical component" that make up the claimed apparatus: "instructs said at least said first telephony platform to have a copy of said customized album mailed to a postal address of said user or downloaded to a computer network address of said user").

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These claims are rejected on obviousness as claim 6 because claiming a non-functional descriptive material in an apparatus claim, and the act of "inputting data" is obvious for any e-commerce transaction (e.g. a multimedia command is a purchasing command); furthermore, the actions of saving, selecting are merely functional descriptive materials that not contributing additional structural components to limiting an apparatus claim. Cited references are capable to perform these claimed functions.

13. As to claim 20: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Bro(US Pat. 5,722,418), Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of Foladare et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and in view of Kelkar et al. (US Pat. 6,182,128).

The rationales and reference for a rejection of claim 17 are incorporated.

Bro, Ellis et al., Foladare et al. and Barbara et al. do not expressly disclose that a multimedia command comprises a radio playback command (please note that for a proper limitation of this "apparatus" claim, the following claimed language does not contribute much weight because it comprises an action/step/ function not being "a structural components" that make up the claimed apparatus: "and wherein said at least said first telephony platform sequentially outputs said saved tracks to said access device in response to said radio playback command").

However, Kelkar et al. suggest that playback actions (see Kelkar et al. 6:22-35).

It would have been obvious with one of ordinary skill in the art to combine Bro, Ellis et al., Foladare et al., Barbara et al., and Kelkar et al. to suggest those radio-button functions as convenient controllable features of users.

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14. As to claims 21-24: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro(US Pat. 5,722,418), Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of Foladare et al. (US Pat. 6,343,115), further in view of Stokes (US Pat. 4,870,515).

The rationales and reference for a rejection of claim 2 are incorporated.

A. As to claim 21: Bro, Ellis et al., or Foladare et al. do not expressly disclose that a multimedia command comprises a forwarding command.

However, Stokes teaches that feature (Stokes disclose, "Also shown are appropriate control push buttons 70 for effecting play, record, fast forward, and pause modes, and a battery compartment 72", and Stokes also discloses: "When a particular *music track* is selected, the circuit 110 causes the deck 36 or player, 40 to fast-forward until the position data agrees with the counted pulses provided from the pulse circuit 132" (please note that for a proper limitation of this "apparatus" claim, the following claimed language does not contribute much weight because it comprises an action/step not "physical components" that make up the claimed apparatus: "a telephony platform forwards a selected multimedia portion to a second access device of a second user in response to a forwarding command" is already actions that are within abilities of Ellis et al. and Foladare's systems). Stokes obviously teaches an apparatus to perform a forwarding command in above-cited paragraph.

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Ellis et al., Foladare et al. and Stokes to receive a forwarding command to Ellis et al., Foladare et al. 's platforms to process desired actions because Bro, Ellis et al. and Foladare et al.'s systems have interactive capabilities.

B. As to claim 23: Stokes also teaches an apparatus comprises a structure to perform forwarding command.

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It would be obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Ellis et al., Foladare et al. and Stokes to receive a forwarding command to Foladare et al. 's platform to process because claim 23's language should be distinguished from cited prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the cited prior art is capable of performing the claimed function "even if not directly disclosed", it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

C. As to claims 22, 24: Foladare et al. also obviously teach a system/an apparatus that having a distribution list (merely a non-functional descriptive material, just information), and obviously including/having claimed capabilities of "wherein said second user is part of a distribution list of a plurality of recipient users, and wherein said distribution list has been created by said user and stored in said at least said first telephony platform prior to inputting said forwarding command"); (please note that the above claimed language does not contribute much weight because it comprises an action/step not "a physical components" that make up the claimed apparatus.

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Bro, Ellis et al., Foladare et al. and Stokes to receive a forwarding command to Foladare et al. 's platform to process because claimed "a distribution list of a plurality of recipient users, and wherein said distribution list has been created by said user and stored in said at least said first telephony platform prior to inputting said forwarding command" are functions that Foladare and Stokes' system would be able to performed.

Conclusion

15. Claims 1-28, and 57-58 are not patentable. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE**

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FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Remark: Please note that applicants are claiming an apparatus in pending claims 1-28, 57-61; therefore, any claiming of functional language should then be limited to an apparatus as to opposed to a process or method.

Because the most detailed apparatus claims 1, and 59 are directed to structures of a machine (please note that claim 59 use a term “means for receiving”, it has exactly a function as claimed in claim 1 (not a “mean-plus-function” claim); the examiner respectfully submits that they claims equivalent structures. A “use” can only be claimed by claiming the use as a process. See *In re Papesch*, 315 F.2d 381, 384, 137 USPQ 1084, 1088 (CCPA 1963). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function “even if not

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directly disclosed", it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

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